

## **REMARKS**

Claims 1-17 were pending in the Application. Claims 2-4, 12-14 and 16-17 are cancelled by this amendment. Claim 18 is added by this amendment. Accordingly, claims 1, 5-11, 15, and 18 are now pending in the Application.

Claims 1-10 were rejected under 35 U.S.C. § 112 on the grounds that an adhesive is removable by various destructive means and therefore the specification lacked support for the apertures being devoid of "removable fasteners." Accordingly applicants have amended claim 1 to recite that the apertures are devoid of "threaded fasteners."

Claims 1-8 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,231,458 to Cameron et al. The claims have now been amended to include limitations that the adhesive forms a layer between the face insert and the cavity bottom, that the adhesive layer extends into the apertures in the rear face of the club head, and that the adhesive layer adheres the face insert to the cavity without the use of threaded fasteners. Cameron et al. discloses a club head in which the elastomeric material disposed in the apertures is a dampening material rather than an adhesive [col. 3, ll. 58-64]. The elastomeric material fills the apertures only. It does not form a layer between the face insert and the bottom wall of the cavity. Instead there is metal to metal contact between the insert and the recess bottom surface. [col. 4, ll. 3-5]. Consequently, the face insert must be secured to the head with threaded fasteners that extend through at least some of the apertures formed in the rear surface of the club. [col. 4, ll. 17-18]. Therefore, for these reasons alone, Cameron does not anticipate the claims as amended.

Additionally, claim 5 has been amended to recite that the apertures are formed in at least two different letters of the alphabet. Therefore, irrespective of whether a circular hole constitutes a letter of the alphabet, Cameron does not anticipate claim 5 as amended. Claim 7 recites a third material disposed in the second cavity. Since claim 7 depends from claim 1, which recites an adhesive layer that extends into the cavity apertures, claim 7 must be interpreted to include a third material *in addition to the adhesive that fills the apertures* (i.e. a fourth material). The Examiner relied on Fig. 8 of Cameron to anticipate original claim 7, however, Fig. 8 of Cameron discloses *the same material* filling both the apertures and the insert back cavity and, therefore could not anticipate a claim that includes a third material filling the second cavity in addition to the adhesive that forms a layer between the face insert and the cavity bottom. Applicants observe that Fig. 16 of Cameron (not relied on by the Examiner) does disclose a third material (foam rubber) between the insert and the elastomeric material that fills the apertures, however, Fig. 16 does not disclose that the third material is disposed in a cavity formed in the back surface of the face insert. Instead, the space is formed by a flange that locates the face insert. Fig. 16 also does not disclose or suggest that the third material permits the elastomeric material filling the cavities to form a layer between the face insert and the cavity bottom. Therefore, for this additional reason, Cameron does not anticipate claim 7 as amended.

Claim 1, 2, 4, 11, 12 and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,729,972 to Boord. As noted above, the claims have been amended to include limitations that the adhesive forms a layer between the face insert and the cavity bottom, that the adhesive layer extends into the apertures in the rear face of the club head, and that the adhesive layer adheres the face insert to the cavity without the use of threaded fasteners. Boord

discloses a club head in which the adhesive layer does not extend into the apertures formed in the rear surface of the club. Therefore, Boord does not anticipate the claims as amended.

Claims 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,921,871 to Fisher. Claim 11 has been amended to recite that the adhesive layer is applied to one of the bottom wall of the cavity and the back surface of the face insert, that it contacts and forms a layer between the face insert and the cavity bottom, and that a portion of the adhesive layer is extruded through the apertures formed in the back surface of the club head to secure the face insert without the use of threaded fasteners. Fisher discloses a face insert that is secured to the club head by threaded fasteners. The laminates are adhesively bonded to each other to form the face insert itself, but the adhesive does not contact and form a layer between the bottom surface of the face insert or the bottom of the cavity, neither is it extruded through the apertures formed in the back surface of the club head. Therefore, Fisher does not anticipate the claims as amended.

Claim 5 was rejected under 35 U.S.C. § 103 as being obvious considering U.S. Patent No. 6,231,458 to Cameron et al. As noted above, the elastomeric material disclosed by Cameron is for vibration dampening, not for securing the face insert to the club head. Accordingly, nothing in Cameron discloses or suggests use of an adhesive that forms a layer between the face insert and cavity bottom that extends into the apertures that attaches the face insert to the club head without the use of threaded fasteners. Accordingly, for this reason alone, claim 5 is not rendered obvious by Cameron. Moreover, applicants believe use of letters to indicate the manufacturer's name, or for the purpose of advertising, is a utilitarian use, not mere aesthetics, because use of

letters conveys information. See for example U.S. Patent No. 6,729,972 to Boord, which is cited by the Examiner, or U.S. Patent No. 5,924,939 to Grace, et al., cited by applicants, both of which include base claims that have limitations relating to advertising indicia.

Claim 13 and 14 were rejected as obvious considering U.S. Patent No. 5,921,871 to Fisher. Insofar as these rejections may be applicable to claim 11 as amended, as noted above, Fisher discloses a face insert that is secured to the club head by threaded fasteners. Although the laminates of the insert itself are adhesively bonded to each other and/or to the backing plate to form the face insert itself, the adhesive does not contact the back surface of the face insert and the bottom of the cavity, does not bond the face insert to the club head, and is not extruded through the apertures formed in the back surface of the club head. Were the adhesive to contact the back surface of the face insert to the bottom surface of the cavity, the face insert of Fisher would be non-interchangeable, rendering the invention disclosed in Fisher unsuitable for its intended purpose. Accordingly, for these reasons, Fisher does not render claim 11 obvious as amended. TMEP 2143.01. With regard to the utility of allowing the adhesive to be extruded through the apertures, as noted in the specification, including at page 1, lines 21-23, allowing the adhesive to be extruded through the apertures allows the excess air as well as any excess adhesive to escape the cavity and to be cleaned easily simply by wiping off the metal back surface of the club head. Nothing in Fisher discloses or suggests this advantage. Accordingly, for this additional reason Fisher does not render claim 11 obvious as amended.

Applicants have introduced new claim 18, which contains the essential limitations of cancelled claim 14. Insofar as the rejection of claim 14 may be maintained against claim 18,

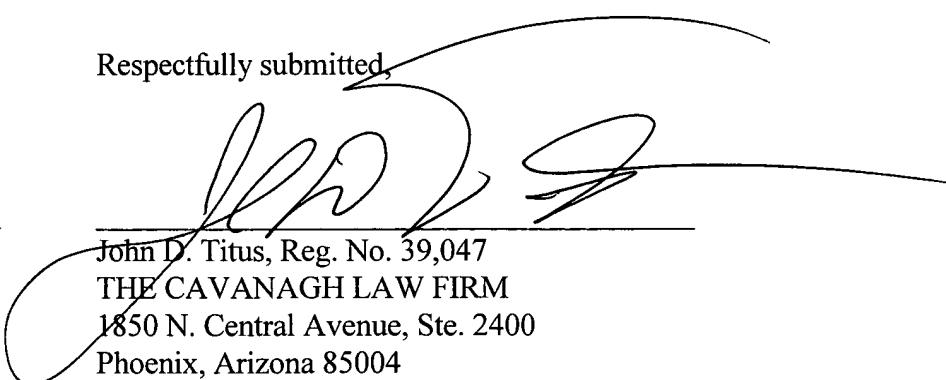
applicants reiterate that use of an adhesive to secure the face directly to the club head would render the face insert non-interchangeable and therefore render the club head of Fisher unsuitable for its intended purpose. Insofar as the utility of adhesive injection is in question, as noted in the specification, including at page 5, lines 9-13, injection of the adhesive facilitates the use of automated equipment.

The specification has been amended to correct a typographical error.

Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

Respectfully submitted,

  
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